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**JUN 27 2003**

**OFFICE OF PETITIONS**

In re Application of: : ON PETITION  
Arita :  
Filed: 1 June, 2001 :  
Application No. 09/871,149 :  
Docket No.: 82084-002 :

This is a decision on the petition filed herein on 6 June, 2003, under 37 C.F.R. §1.137(b)<sup>1</sup> to revive the above-identified application.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**BACKGROUND**

The record indicates that:

- Petitioner Stephen B. Parker (Reg. No. 36,631) (Petitioner) failed to reply timely and properly to the Notice to File Missing Parts (fees and oath/declaration with surcharge) mailed by the Office to Petitioner's former office Hogan and Hartson (Hogan) on 31 July, 2001, with reply due (absent extension of time) on or before Monday 1 October, 2001;
- the application was deemed abandoned after midnight 1 October, 2001;

<sup>1</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

- Petitioner filed a Notice of Change of Correspondence address (from Hogan to Rothwell, Figg Ernst & Manbeck (Rothwell)) on 5 December 2002, and the Office acknowledged that filing on 10 March, 2003;
- Notice of Abandonment was mailed on 14 April, 2003;
- in the original petition filed on 2 May, 2003, under 37 C.F.R. §1.137(a) (and, in light of allegations of non-receipt considered under 37 C.F.R. §1.181) Petitioner failed to support those allegations and the petitions were dismissed on 22 May, 2003;
- with the instant petition (with fee) Petitioner makes the statement of unintentional delay; and
- the reply to the Notice of Missing Parts has been filed, thus satisfying the "reply" requirement under the regulation.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

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<sup>2</sup> 35 U.S.C. §133 provides:  
**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup>

And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>)

As to Unintentional Delay

Petitioner has authorized the fee, made the statement of unintentional delay, and submitted authorization for the required reply(ies).

CONCLUSION

Accordingly, the petition to revive under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is being forwarded to Technology Center 3600 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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Office of Petitions

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<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.